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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/484,098

01/18/2000

Albert D. Baker

19-3

9279

7590  
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90 Forest Avenue  
Locust Valley, NY 11560

12/19/2006

EXAMINER

TODD, GREGORY G

ART UNIT

PAPER NUMBER

2157

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/19/2006

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/484,098	BAKER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gregory G. Todd	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS; WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Appeal Brief***

1. This office action is in response to applicant's appeal brief filed, 28 August 2006, of application filed, with the above serial number, on 18 January 2000 in which claims 1-21 are pending in the application.

In view of the Appeal Brief filed on 28 August 2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. MPEP 2106 states:

"For an invention to be "useful" it must satisfy the utility requirement of section 101. The USPTO's official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. MPEP § 2107 and Fisher, 421 F.3d at 1372, 76 USPQ2d at 1230 (citing the Utility Guidelines with approval for interpretation of "specific" and "substantial"). In addition, when the examiner has reason to believe that the claim is not for a practical application that produces a useful result, the claim should be rejected, thus requiring the applicant to distinguish the claim from the three 35 U.S.C. 101 judicial exceptions to patentable subject matter by specifically reciting in the claim the practical application. In such cases, statements in the specification describing a practical application may not be sufficient to satisfy the requirements for section 101 with respect to the claimed invention. Likewise, a claim **that can be read so broadly as to include statutory and nonstatutory subject matter** must be amended to limit the claim to a practical application. In other words, if the specification discloses a practical application of a section 101 judicial exception, but the claim is broader than the disclosure **such that it does not require a practical application**, then the claim must be rejected." [Emphasis added]

In this case, the claims can be read broadly enough so as to include non-statutory subject matter. Independent claims 1, 11, and 21, disclose a gateway, coupled between a local network, having devices thereon, and external network elements (eg. remote network). Thus, the devices on the local network *must* communicate with the gateway, in order to communicate with the remote network. However, the claims suggest being given remotely-assigned address information without having ever established an address for use within the local network. As such, as is well known in the art, the given device must establish an address with the gateway, prior to communicating with the remote network. Once a 'local' address is given to the given device, *only then*, may the given device communicate with the remote network and be

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remotely assigned address information. However, the claims assert that the substitution address be established *after* a remotely-assigned address is given to the given device. As such, the claims would require at the least the step of having a 'local' address be given to the given device prior to being given a remotely-assigned address, and then it may re-establish the local address based on the remotely-assigned address information.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: having a 'local' address given to the given device prior to being given a remotely-assigned address.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1-3, 5-13, and 15-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Kondo et al (hereinafter "Kondo", 6,088,725).

As per Claims 1, 11 and 21, Kondo teaches an apparatus, a method, and a machine-readable medium storing one or more programs for use in interfacing a local network to one or more external network elements, wherein Kondo teaches:

a gateway coupled between the local network and the one or more external network elements, the gateway being operative to determine remotely-assigned address information for a given device attached to the local network (at least col. 9, lines 15-40; assignment of present address); and to establish, based at least in part on the remotely-assigned address information, a substitution address for use by at least one other device attached to the local network when communicating with the given device (at least col. 9, lines 15-40; col. 10, lines 5-52; using address conversion processing via extracted address information).

As per Claims 2 and 12.

the remotely-assigned address information comprises an Internet protocol (IP) address assigned to the at least one device by an external network element (at least col. 5, lines 15-33).

As per Claims 3 and 13.

the local network comprises a local area network (LAN) (at least 5, lines 1-33).

As per Claims 5 and 15.

the gateway stores remotely-assigned address information for each of a plurality of devices attached to the local network (at least col. 7, lines 1-39; table storing).

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As per Claims 6 and 16.

the gateway stores a set of address information for each of the plurality of devices, the set of address information for a given one of the devices comprising an address to be used by the given device in communicating with the gateway, and addresses to be used by the given device in communicating with each of the other devices (at least col. 7, lines 1-39; Fig. 1; eg. each PC101).

As per Claims 7 and 17.

the stored information comprises an address substitution matrix having a row of address information for each of the plurality of devices attached to the local network (at least col. 7, lines 1-39; correspondence table).

As per Claims 8 and 18.

a given one of the sets of address substitution information for a particular one of the plurality of devices comprises a set of IP addresses, each of which is sub-network compatible with an IP address remotely assigned to the corresponding device, such that communications between the given device and another one of the devices attached to the local network are not routed through an external network element (at least col. 5, lines 15-33; routing control for which network to be relayed).

As per Claims 9 and 19.

the gateway processes a particular received packet in order to replace remotely-assigned address information in a header thereof with a corresponding substitution address determined by the gateway (at least col. 7, lines 40-67; address replacing).

As per Claims 10 and 20.

the gateway intercepts at least one of control information and maintenance information received over the local network and associated with the given device so as to perform related services on behalf of the given device (at least col. 5, lines 15-61; control).

6. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo in view of Gelman et al (hereinafter "Gelman", 6,493,348).

Kondo does explicitly disclose the gateway comprising an ADSL termination unit-receive device (ADSL modem). However, the use and advantages for using such a modem is well known to one skilled in the art at the time the invention was made as evidenced by the teachings of Gelman (at least Gelman col. 6, lines 5-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of specifically an ADSL modem into Kondo's system because this would simply expand the compatibility of Kondo's system and network transit devices such as a router (at least col. 4, lines 10-20) with future systems and networks such as xDSL / ADSL networks and ATU-R's.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.



***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Newly cited Tari et al (address conversion) and Schuster et al (mapping of IP addresses), in addition to previously cited Tari et al, Radia et al, Arrow et al, Sekine et al, and Slemmer et al, RFC 1597, Kracht, Gervais et al, Akatsu et al, Nonaka et al, Hong et al, Zisapel et al, Subramaniam et al, Howes et al, Millet et al, Weiman, Nonaka et al (packet substitution gateways), and Datta et al (multiple routers controllable by address configuring gateway) are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Grégory G. Todd whose telephone number is (571)272-4011. The examiner can normally be reached on Monday - Friday 9:00am-6:00pm w/ first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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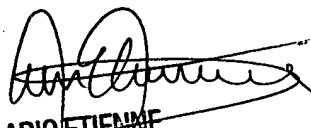
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Gregory Todd



Patent Examiner

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